

REMARKS

Claims 1-19 are pending in the Application, though claims 2-9, 12-15, and 18-19 have been canceled in the instant Amendment. Of the claims remaining in the case, claims 1, 16, and 17 are independent claims. Claims 1-4, 6-8, 10-11, and 16-17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,333,433 to Porambo et al., and claims 5, 9, 12-13, and 18-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Porambo.

For the reasons set forth below, Applicant respectfully traverses these rejections, and reexamination and reconsideration of the Application in connection with the remaining claims is respectfully requested. For simplicity, Applicant has focused the present responsive Amendment on those specific issues raised in the instant Office Action, though all other arguments for allowance of the claims as previously presented are incorporated herein by reference to the extent that they are consistent with and relevant to the current amendments and arguments.

35 U.S.C. § 102(b) Rejections

Claims 1-4, 6-8, 10-11, and 16-17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,333,433 to Porambo et al. As claims 2-4 and 6-8 have been canceled, Applicant will focus the present discussion on claims 1, 10-11, and 16-17.

Referring to Figure 2 and the text at column 5, lines 3-23, and column 6, lines 4-12, of the Porambo reference, it is indicated that Porambo has attempted to improve on the less efficient and less optimal multiple layering of joint cement in finishing a drywall joint by eliminating such

altogether and instead flushing the joint with tape having a pre-applied adhesive backing.

Clearly, the Porambo taping system only discloses a drywall joint finishing system that includes a *tape* forming the center-line surface with a pre-installed adhesive on its opposite side, and that system only for a construction entailing conventional recessed drywall boards. Porambo simply makes no disclosure of a joint finishing system that would *not* include tape, or the use of such a system in the context of non-recessed boards, which simply would not work as there would be no place for the adhesive to flow around the marginal edges of the tape to flush the joint as Porambo shows in Figures 2 and 3 and explains at column 5, lines 3-9. Ultimately, tape is the critical component of the Porambo joint finishing system – without it there would be no carrier for the adhesive and no finished surface of the drywall joint.

In this regard, it is necessary at the outset to correct one mischaracterization of the Porambo reference made throughout the instant Office Action. The Examiner has indicated that the disclosure associated with Figures 4D and 5 of Porambo somehow relates to non-recessed drywall boards and so discloses “a non-shrinking caulk . . . forming the flexible layer and filling the slit [between boards] so as to flush the joint finishing system with the first and second planar surfaces.” However, it is clear that the structure of the drywall boards in all examples within Porambo is the conventional recessed configuration, Figures 4D and 5 in that respect being identical to Figures 2 and 3, for example, whereby the tapered recess formed between abutting boards is then filled in and covered over by the tape/adhesive pre-assembly as applied.

In contrast to the Porambo joint construction, in Applicant’s claimed joint construction, caulk alone forms the center-line surface of the joint, with the tape being eliminated altogether

along with conventional joint cement. In that regard, Applicant notes that, as required by Section 2111.03 and the cases cited therein, Applicant has made clear in at least one embodiment in the Specification and by the current claim language that the claimed joint construction and method of use does *not* include joint cement *or* tape forming the center-line surface of the joint, or being used anywhere in the joint for that matter. See page 7, lines 9-12; page 9, lines 11-18; and page 12, lines 16-22; and Figure 4. Applicant thus contends that any joint construction or methodology that includes joint cement over the flexible layer of caulk or that has tape anywhere in the joint, whether over or embedded in the caulk, *does* “materially affect the basic and novel characteristics” of Applicant’s invention for the reasons stated above and so is structure that is excluded from the scope of the claims, even with the “consisting essentially of” transitional phrase. Therefore, any joint construction that includes conventional drywall joint cement *or* tape is expressly not within the scope of the claims. Or put another way, Applicant’s invention as disclosed and now claimed requires that *only* a flexible compound such as caulk be used in flushing the joint and nothing else, including tape.

Accordingly, since claim 1 as now written recites “a joint finishing system installed within the crack to complete the drywall joint construction, the system including a flexible layer forming the center-line surface, the flexible layer being a caulk,” it is clear that such structure is not disclosed in Porambo or any other prior art of record. Again, all prior art of record shows the use of joint cement and/or tape forming the center-line surface of the joint in one or more layers, which structure is clearly outside the scope of claim 1, wherein only a flexible layer or compound such as caulk forms the center-line surface in flushing the joint.

Since claim 1 has thus been shown to be allowable over the prior art of record, it follows that claims 10 and 11 that depend therefrom are also allowable. Specifically, claim 10 further limits claim 1 by reciting that “the first lengthwise edge [of the first drywall board] is substantially perpendicular to the first planar surface and the second lengthwise edge [of the second drywall board] is substantially perpendicular to the second planar surface such that the crack is configured as an outwardly-opening slit”; i.e., the use of non-recessed drywall boards between which is formed a slit that is then filled in by the caulk to finish the joint. Again, Porambo clearly only discloses the use of conventional recessed drywall boards, as non-recessed boards would not allow the adhesive to flow around the marginal edges of the tape to flush the joint as Porambo shows and describes in connection with at least Figures 2 and 3.

Turning to independent claim 16, with the term “flexible compound” having been previously replaced by “caulk” throughout in addressing an earlier objection by the Examiner, this claim is now allowable over the prior art of record as again reciting a caulk filling the crack or slit between abutting *non-recessed* drywall boards so as to form the critical center-line surface and flush the joint. Because the prior art simply makes no such disclosure of such a flexible caulk layer forming the center-line surface, particularly between non-recessed boards so as to eliminate tape altogether, Applicant respectfully urges that claim 16 is also allowable as written.

Similarly, method claim 17 recites the step of “filling the crack with a caulk so as to form the center-line surface and to flush the drywall joint with the first and second planar surfaces,” which methodology is also simply not taught or suggested by the prior art of record, including

Porambo, which, in fact, teaches away from such through the disclosed system and method employing only tape having a pre-applied adhesive.

Returning again to the use of the “consisting essentially of” transitional phrase in the claims, as pointed out above, Applicant has chosen this language to make clear that certain additional structure and steps, namely, employing tape or conventional joint cement, are expressly excluded from the claims as materially altering Applicant’s invention wherein joint cement and tape are removed from the joint altogether, and particularly the center-line surface. Thus, in claims 1, 10-11, and 16-17, where caulk expressly forms the center-line surface, by the claim language read in light of the Specification, tape thus cannot also be at the center-line surface, and since tape is not to be anywhere else, tape is thus excluded from the joint construction altogether in all remaining claims by use of the “consisting essentially of” phrase; that is, the use of tape underneath the caulk would materially affect the basic and novel characteristics of the invention and so is not encompassed by the claims as now written.

But by comparison, Applicant has intentionally *not* used the transitional phrase “consisting of” so as to not unnecessarily limit the claims from additional structure that does *not* materially affect the claimed invention. For example, any such joint as now claimed can be finished in a conventional fashion after having been flushed using caulk, such as by texturing, painting, wall-papering, or the like.

In sum, in connection with the Section 102(b) rejections, as distinct from the drywall joint construction shown and described by Porambo, Applicant’s joint construction in at least one

embodiment essentially entails the absence of conventional joint cement or tape anywhere in the joint, particularly at the center-line surface of the joint, and instead the use of a flexible material or compound such as caulk at the center-line surface. In this way, it will be appreciated that the drywall joint is finished more quickly and less expensively than in both the conventional method and the taping system of Porambo, with less materials and time, or labor costs, required.

With this understanding of the differences between the identified prior art and Applicant's invention, it is abundantly clear that the subject matter of independent claims 1, 16, and 17 is allowable over the art of record. Again, as the Examiner noted in the first Interview Summary, Applicant has employed the relatively closed transitional phrase "consisting essentially of," rather than the open phrase "comprising," in all such claims, whether for the joint construction itself or the method of its use, in order to make clear that the entire joint construction or methodology (i.e., all of its constituent parts or steps) is recited and anything not recited is not and cannot be part of the claimed invention (i.e., conventional joint cement *and* tape), except for those further features "that do not materially affect the basic and novel characteristics" of the claimed invention.

35 U.S.C. § 103(a) Rejections

Claims 5, 9, 12-13, and 18-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Porambo. However, each of these claims has now been canceled, so the Section 103 rejections are moot.

Based on the foregoing, and the information provided by Applicant during the interview on March 15, 2007, relating to the commercial response to his invention has already received, it is clear that Applicant has made a valuable contribution to the art of drywall joint finishing by providing a system and method effectively antithetical to decades of industry tradition and accepted practices and that actually overcomes deficiencies in those practices and yields a joint construction that is both improved and relatively less costly. It is respectfully submitted, then, that claims 1, 10-11, and 16-17 as presently pending all distinguish over the art of record and are in condition for immediate allowance. Prompt and favorable notice thereof is respectfully requested.

CONCLUSION

From the foregoing it is apparent that Applicant has made a valuable contribution to the art. All claims now in the case patentably distinguish over the prior art of record and are in condition for allowance. Consequently, early notice of allowance is respectfully solicited. If the Examiner is not in agreement, it is requested that she feel free to telephone the undersigned to discuss any concerns that may remain regarding allowance of the rejected claims.

Respectfully submitted,

MIND LAW FIRM

A handwritten signature in black ink, appearing to read "Jeromye V. Sartain", with a long horizontal flourish extending to the right.

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